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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/658,525 | 09/10/2003 | Hitoshi Yoshino | 03500.009931.7 | 5353 |

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NEW YORK, NY 10112

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| EXAMINER |
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SCHWARTZ, PAMELA R

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| ART UNIT | PAPER NUMBER |
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1774

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/658,525 | YOSHINO ET AL. | |
| | Examiner | Art Unit | |
| | Pamela R. Schwartz | 1774 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 44-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20030924</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1774

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44 and 50-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,869,177. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are directed to a recording medium have a base of pulp fibers and filler in which the filler is alumina hydrate meeting the limitations of claim 44. The method step of applying as a dispersion on a base material would have been a conventional method of forming the article of the patent claims.

2. Claims 44 and 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,869,177 in view of Oberlander et al. (4,360,449). See the explanation above with respect to applicants' patent. The secondary art discloses that it is advantageous in forming alumina dispersions and having them remain fluid to include a small amount of an

Art Unit: 1774

aqueous acid (see the abstract). In the examples, the alumina is an alumina hydrate and the acid is nitric acid. This will inherently result in nitrate ions in the alumina hydrate. The quantities of acid disclosed by the reference examples appear consistent with the nitrate concentrations recited by claim 47. Based upon the teaching of advantages in creating an alumina hydrate dispersion through inclusion of small amounts of nitric acid, it would have been obvious to one of ordinary skill in the art to include such an acid treated alumina hydrate dispersion in the method of making the medium of applicants' patented claims. Once again, the process limitation is a conventional method of forming the article and would have been obvious to one of ordinary skill in the art.

3. Claims 45 and 49-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,800,916. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are directed to a recording medium have a base of pulp fibers and filler in which the filler is alumina hydrate meeting the limitations of claim 45. The method step of applying as a dispersion on a base material would have been a conventional method of forming the article of the applicants' patent claims.

4. Claims 45 and 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,800,916 in view of Oberlander et al. (4,360,449). See the explanation above with respect to applicants' patent. The secondary art discloses that it is advantageous in forming

alumina dispersions and having them remain fluid to include a small amount of an aqueous acid (see the abstract). In the examples, the alumina is an alumina hydrate and the acid is nitric acid. This will inherently result in nitrate ions in the alumina hydrate. The quantities of acid disclosed by the reference examples appear consistent with the nitrate concentrations recited by claim 47. Based upon the teaching of advantages in creating an alumina hydrate dispersion through inclusion of small amounts of nitric acid, it would have been obvious to one of ordinary skill in the art to include such an acid treated alumina hydrate dispersion in the method of making the medium of applicants' patented claims. Once again, the process limitation is a conventional method of forming the article and would have been obvious to one of ordinary skill in the art.

5. Claims 44-46 and 48-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,851,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are directed to a recording medium have a base of pulp fibers and filler in which the filler is alumina hydrate meeting the limitations of one or more of claims 44-46. The method step of applying as a dispersion on a base material would have been a conventional method of forming the article of the applicants' patent claims.

6. Claims 44-46 and 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,851,654 in view of Oberlander et al. (4,360,449). See the explanation above with

Art Unit: 1774

respect to applicants' patent. The secondary art discloses that it is advantageous in forming alumina dispersions and having them remain fluid to include a small amount of an aqueous acid (see the abstract). In the examples, the alumina is an alumina hydrate and the acid is nitric acid. This will inherently result in nitrate ions in the alumina hydrate. The quantities of acid disclosed by the reference examples appear consistent with the nitrate concentrations recited by claim 47. Based upon the teaching of advantages in creating an alumina hydrate dispersion through inclusion of small amounts of nitric acid, it would have been obvious to one of ordinary skill in the art to include such an acid treated alumina hydrate dispersion in the method of making the medium of applicants' patented claims. Once again, the process limitation is a conventional method of forming the article and would have been obvious to one of ordinary skill in the art.

7. Claims 44-46 and 48-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,846,647. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are directed to a recording medium have a base of pulp fibers and filler in which the filler is alumina hydrate meeting the limitations of one or more of claims 44-46. The method step of applying as a dispersion on a base material would have been a conventional method of forming the article of the applicants' patent claims.

8. Claims 44-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,846,647

in view of Oberlander et al. (4,360,449). See the explanation above with respect to applicants' patent. The secondary art discloses that it is advantageous in forming alumina dispersions and having them remain fluid to include a small amount of an aqueous acid (see the abstract). In the examples, the alumina is an alumina hydrate and the acid is nitric acid. This will inherently result in nitrate ions in the alumina hydrate. The quantities of acid disclosed by the reference examples appear consistent with the nitrate concentrations recited by claim 47. Based upon the teaching of advantages in creating an alumina hydrate dispersion through inclusion of small amounts of nitric acid, it would have been obvious to one of ordinary skill in the art to include such an acid treated alumina hydrate dispersion in the method of making the medium of applicants' patented claims. Once again, the process limitation is a conventional method of forming the article and would have been obvious to one of ordinary skill in the art.

9. Claims 45 and 49-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,962,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are directed to a recording medium have a base of pulp fibers and filler in which the filler is alumina hydrate meeting the limitations of one or more of claim 45. The method step of applying as a dispersion on a base material would have been a conventional method of forming the article of the applicants' patent claims.

Art Unit: 1774

10. Claims 45 and 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,962,124 in view of Oberlander et al. (4,360,449). See the explanation above with respect to applicants' patent. The secondary art discloses that it is advantageous in forming alumina dispersions and having them remain fluid to include a small amount of an aqueous acid (see the abstract). In the examples, the alumina is an alumina hydrate and the acid is nitric acid. This will inherently result in nitrate ions in the alumina hydrate. The quantities of acid disclosed by the reference examples appear consistent with the nitrate concentrations recited by claim 47. Based upon the teaching of advantages in creating an alumina hydrate dispersion through inclusion of small amounts of nitric acid, it would have been obvious to one of ordinary skill in the art to include such an acid treated alumina hydrate dispersion in the method of making the medium of applicants' patented claims. Once again, the process limitation is a conventional method of forming the article and would have been obvious to one of ordinary skill in the art.

11. Claims 44 and 50-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,635,291. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are directed to a recording medium have a base of pulp fibers and filler in which the filler is alumina hydrate meeting the limitations of claim 44. The method step of applying as a dispersion on a base material would have been a conventional method of forming the article of the patent claims.

Art Unit: 1774

12. Claims 44 and 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,635,291 in view of Oberlander et al. (4,360,449). See the explanation above with respect to applicants' patent. The secondary art discloses that it is advantageous in forming alumina dispersions and having them remain fluid to include a small amount of an aqueous acid (see the abstract). In the examples, the alumina is an alumina hydrate and the acid is nitric acid. This will inherently result in nitrate ions in the alumina hydrate. The quantities of acid disclosed by the reference examples appear consistent with the nitrate concentrations recited by claim 47. Based upon the teaching of advantages in creating an alumina hydrate dispersion through inclusion of small amounts of nitric acid, it would have been obvious to one of ordinary skill in the art to include such an acid treated alumina hydrate dispersion in the method of making the medium of applicants' patented claims. Once again, the process limitation is a conventional method of forming the article and would have been obvious to one of ordinary skill in the art.

13. Claim 46, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' admissions of pages 1-6 and 44 of applicants' specification. Applicants' disclose that it is known in the prior art to include titania as an additive in pseudoboehmite (see p. 44). Claim 44 does not distinguish titania included as an additive in the pseudoboehmite, therefore, the claim reads on applicants' admissions of titania as a known additive, that recording media are known and formed from dispersions of particles applied to a support.

14. Claims 46-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Pages 44 and 45 disclose that the titania must be more than simply mixed with the alumina hydrate, it has to be present so that a significant portion of the titania is present in the pores of the alumina hydrate. Claim 46 does not distinctly claim this structure and reads on the description of the prior art on page 44 of the specification.

15. In all of the above rejections, coating amounts of claims 50 and 51 are conventional and would have been obvious to one of ordinary skill in the art.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

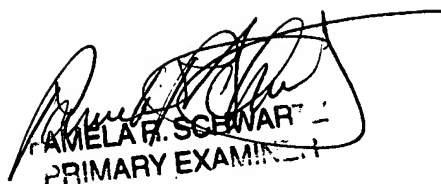
Application/Control Number: 10/658,525

Page 10

Art Unit: 1774

PRSchwartz

April 28, 2006


PAMELA R. SCHWARTZ
PRIMARY EXAMINER